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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,541	05/29/2001	Tsunekazu Ishihara	3917-4	4238

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EXAMINER	
COBURN, CORBETT B	
ART UNIT	**PAPER NUMBER**
3714	

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22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/866,541	ISHIHARA ET AL.	
	Examiner	Art Unit	
	Corbett B. Coburn	3714	

-- The MAILING DATE of this communication app ars on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,8-16 and 18-72* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,8-16 and 18-72* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *29 May 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *21*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claim 1, 13-15, 19, 21, 22, 25, 26, 28-32, 34, 36, 39-48, 50-54, 56-59 & 63-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokoyama et al. (US Patent Number 6,484,942) in view of Bronstein (US Patent Number 4,386,773) & Eskildsen (US Patent Number 5,962,839).

Claims 1, 13, 25, 28, 31, 32, 44, 47, 48, 54, 63, 65, 67: Yokoyama teaches a game system having a plurality of cards. (Disks, 10a & 10b) The cards visually portray a figure (Fig 1a) and include recorded data (Fig 1b) for use in a card game. (Abstract) There is a game information storage medium (46, 47) storing a game program relating to game card figures. There is a processing system (Fig 6) for receiving therein the game information storage medium. The game machine executes an image display game program that is stored in the memory section. (Col 7, 57-65) The cards store, for each character depicted, identification data and characteristic data relating to a characteristic of an associated character and for causing a change to a graphics image involving a displayed associated character dependent on the progress of the image-displaying game. (Figs 8-14) The card contains data concerning the strength of the character and any skills or defenses. The data is read by the processor and used to determine success and failure

of attempted attacks and defenses. The display (Fig 5a-b) lights up in an appropriate manner depending on the outcome. This changes the graphics image involving a displayed associated character dependent on the progress of the image-displaying game. The game system has a game piece reader (23a & b) for reading the identification and characteristic data from the card. The processing system processes the supplied identification and characteristic data from one or more game cards (a first and second card) in accordance with the game program stored in a second game program memory section. (Figs 7a-14) It is necessary to read the game cards in order to play the game.

The game information storage medium does not appear to be readily removable from the processing system. Having a removable game information storage medium is extremely well known to the art. This allows the game machine to be used for different games. Bronstein teaches a removable game information storage medium (i.e., data cartridge). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Yokoyama in view of Bronstein to include a removable game information storage medium in order to allow the game machine to be used for different games.

While the processing system may be said to process the characteristic data to apply a change to the original content of the game program stored in the game information storage medium – the processing system updates the variables based on the information read from the cards -- Examiner believes that the claim is directed toward changing program steps. This is not taught by Yokoyama.

Eskildsen teaches a game device that reads a barcode to change the steps taken by the program. (Abstract) Each of the barcodes (corresponding to a single card) represents a program instruction that is executed by the game machine. This allows the user to interactively program the device, thus increasing the flexibility of the game. It would have been obvious to one of ordinary skill in the art at the time of the invention to have the processing system process the characteristic data to apply a change to the original content of the game program stored in the game information storage medium in order to allow the player to interactively program the device, thus increasing the flexibility of the game.

Claims 8, 14, 19, 34, 50, 56: Yokoyama teaches providing appropriate sound data via barcodes and generating sounds based on this data. (Fig 25)

Claims 10, 22, 36, 51, 64, 66: Yokoyama teaches a card reader (23a & b) is an optical reader for optically reading the identification and characteristic data corresponding to the character visually depicted on the card. Yokoyama teaches a game card that records the identification and characteristic data may be in the form of a two-dimensional array of dots. (Fig 30)

Claim 15: Yokoyama teaches that the characteristic data includes ability data related to the character and the processing system generates a display state of the character in the game based on the ability data read by the external information reading circuit. (Col 6, 39 – Col 7, 10)

Claim 21: Yokoyama teaches an identification code (barcode) on the card. (Abstract) This card identifies the visually portrayed character. The data stored on the card is, in and of itself, "data for determining the amount of data recorded".

Claims 26, 41, 43, 52 & 68: Yokoyama teaches a groove (22 a & b) for receiving at least a portion of the card and reading the card. Yokoyama does not, however, teach putting the groove and card reader on a removable memory cartridge. Bronstein teaches a memory cartridge for containing game program information. These are typically used in home video game systems to store programs and provide specialized circuitry required for the game. Home video games are extremely popular. It would have been obvious to one of ordinary skill in the art at the time of the invention to have mounted the card reader on the removable cartridge in order to implement Yokoyama's disclosure on a home video game system, thus taking advantage of the tremendous popularity of these systems. As Bronstein clearly illustrates (Figs 2 & 3), these cartridges contain a semiconductor memory for storing programs and a case accommodating the memory.

Claims 29, 45: Yokoyama and Eskildsen teach the invention substantially as claimed but do not specifically teach a game cartridge including processing circuits. Game cartridges are extremely well known in the art. Bronstein provides but one example. Game cartridges are used to prevent software piracy. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used a game cartridge in order to prevent software piracy.

Claims 30, 46, 53: Yokoyama, Fig 2a shows a hand-held device including a display (28a & b).

Claim 39: Yokoyama and Eskildsen teach the invention substantially as claimed. Yokoyama teaches program memory (46, 47) for storing a game program involving cards. (Abstract) Yokoyama teaches a data reader (23a & b) for reading data from at least one card and processing circuits for processing data read from the card. There is a connector connecting the card reader to the game machine having a processing system for executing a game program. (Fig 6) But Yokoyama does not teach a removable memory. Game cartridges are extremely well known in the art. Bronstein provides but one example. Game cartridges are used to prevent software piracy. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used a game cartridge in order to prevent software piracy.

Claim 40: Bronstein teaches a cartridge with RAM (32).

Claim 42: Yokoyama teaches a game machine that executes an image display game program that is stored in one memory section. The cards store, for each character depicted, identification data and characteristic data relating to a characteristic of an associated character. The game system has a game piece reader (23a & b) for reading the identification and characteristic data from the card. The processing system processes the supplied identification and characteristic data in accordance with the game program stored in a second game program memory section. (Figs 12-15)

Claim 57: Yokoyama teaches a game system having a plurality of cards. (Abstract) The cards visually portray a figure and include recorded data for use in a card game. There is a game information storage medium (46, 47) storing a game program relating to game card figures. There is a processing system for removably receiving therein the

game information storage medium. (Fig 3) The game machine executes an image display game program that is stored in one memory section. The cards store, for each character depicted, identification data and characteristic data relating to a characteristic of an associated character. (Figs 12-15) The game system has a game piece reader (23 a & b) for reading the identification and characteristic data from the card. The processing system processes the supplied identification and characteristic data from one or more game cards in accordance with the game program stored in a second game program memory section. (Figs 12-15) The processing system, when not supplied with the identification data and characteristic data by the card reader (23 a & b) executes a process on the basis of only the game program stored in memory – one-player mode. While the processing system may be said to process the characteristic data to apply a change to the original content of the game program stored in the game information storage medium – the processing system updates the variables based on the information read from the cards -- Examiner believes that the claim is directed toward changing program steps. This is not taught by Yokoyama.

Eskildsen teaches a game device that reads a barcode to change the steps taken by the program. (Abstract) This allows the user to interactively program the device, thus increasing the flexibility of the game. It would have been obvious to one of ordinary skill in the art at the time of the invention to have the processing system process the characteristic data to apply a change to the original content of the game program stored in the game information storage medium in order to allow the player to interactively program the device, thus increasing the flexibility of the game.

Yokoyama also fails to teach putting the game program in a removable storage medium. Bronstein teaches a memory cartridge for containing game program information. These are typically used in home video game systems to store programs and provide specialized circuitry required for the game. Home video games are extremely popular. It would have been obvious to one of ordinary skill in the art at the time of the invention to have mounted the card reader on the removable cartridge in order to implement Yokoyama's disclosure on a home video game system, thus taking advantage of the tremendous popularity of these systems. As Bronstein clearly illustrates (Figs 2 & 3), these cartridges contain a semiconductor memory for storing programs and a case accommodating the memory.

Claims 58 & 59: Claims 58 & 59 contain the limitations of claim 57 (which see) plus a limitation that state that the first storage section contains a program that checks the card reader to see if data is available and writes the data to the second memory area. Yokoyama teaches this. (Figs 12-15)

Claim 69, 72: Yokoyama teaches determining whether a sufficient number of cards have been read to execute the game. (I.e., in one player or two player modes.) In order to make this determination, the game must base the execution of the game on total amount data. This data is derived from information read from the cards – i.e., the number and type of cards read.

Claims 70, 71: Eskildsen teaches that the barcodes may be read in any order desired by the player. Thus the order may be rearranged.

3. Claims 11, 12, 16, 23, 24, 37 & 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokoyama, Bronstein & Eskildsen as applied to claim 1 or 28 above, and further in view of Hara (US Patent Number 5,212,368). Note: Claim 16 contains the limitations of claim 1 with the additional limitations discussed below..

Claims 11, 12, 16, 23, 24, 37 & 38: Yokoyama, Bronstein & Eskildsen teach the invention substantially as claimed, but do not teach a magnetic card. Hara teaches that the card data may be recorded on non-volatile memory (i.e., a magnetic medium) and read therefrom via a magnetic reader. (Col 8, 8-11) In this embodiment, the characteristic data includes ability data recognizably printed on the game card and hidden data not visibly printed on the game card. The picture with identifying information is recognizably printed on the game card while the data stored on the magnetic medium is not visibly printed. It is well known that magnetic cards and barcodes are equivalent. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Yokoyama, Bronstein and Eskildsen in view of Hara to make use of a magnetic card in order to achieve an equivalent function with an equivalent structure.

4. Claim 7, 9, 18, 27, 33, 35, 49, 55 & 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokoyama, Bronstein & Eskildsen as applied to claim 1, 16, 25, 28, 44 or 54 above, and further in view of Garfield (US Patent Number 5,662,332).

Claims 7, 33, 49, 55: Yokoyama, Bronstein and Eskildsen teach a game machine using cards to play a game associated with a game program. Yokoyama teaches that the game cards are pogs. Pogs are collecting cards, but Yokoyama does not explicitly teach a trading card game with characters of differing rarity values. Garfield teaches a trading

card game including a figure of a character differing in rarity value. (Col 7, 56-58) Garfield teaches having cards of differing rarity values increases the value of the game components (rare cards) and encourages players to trade and collect game cards. (Col 7, 12-20) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Yokoyama's card game by including trading cards of differing in rarity value as suggested by Garfield in order to increase the value of the game components (rare cards) and encourages players to trade and collect game cards.

Claims 9, 35: Garfield teaches including text on the card explaining an individual feature of the character. (Fig 1B) Garfield teaches a computer version of the game in which the text is displayed on the screen.

Claims 18, 60: Yokoyama teaches storing data on the card that affects the game but does not teach storing additional data that includes a mini-game program that may be added to the game based on the game program stored in the game information medium. Garfield teaches storing additional data including mini-game data for playing a game based on the game programs stored in the game information storage medium (i.e., duels between wizards (Col 7, 43-45), monster attacks (Col 4, 21-26), etc.). These mini-games add interest to the game. It would have been obvious to one of ordinary skill in the art at the time of the invention to have included mini-game information for playing a game based on the game programs stored in the game information storage medium in order to add interest to the game.

Eskildsen teaches a game device that a player can reprogram using barcodes. This is equivalent to adding a mini-game program to the game based on the game

program stored in the game information medium. Use of barcodes to enter program information would automate the process of playing the mini-games described in Garfield. It would have been obvious to one of ordinary skill in the art to stored additional data on the card that includes a mini-game program that may be added to the game based on the game program stored in the game information medium in order to automate the process of playing the mini-games described in Garfield.

Claim 27: Yokoyama teaches cards that store a plurality of kinds of characteristic data (i.e., power, offensive & defensive data) on an identification-code -by- identification-code basis – i.e., each is recorded on a barcode. Yokoyama has a computer (Fig 6) with semiconductor solid-state memory for storing characteristic data. The computer is in a case (Fig 2) and is integrally formed with the card reader.

5. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yokoyama, Bronstein & Eskildsen as applied to claim 16 above, and further in view of Garfield.

Claim 20: Yokoyama, Bronstein and Eskildsen teach the invention substantially as claimed. Yokoyama teaches providing appropriate sound data stored on the card. (Fig 15) Yokoyama, Bronstein & Eskildsen do not specifically teach text data explaining a feature of the character. Garfield teaches text data (16) explaining a feature of a character. Providing text data explaining a feature of a character makes the game easier to play. It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided text data explaining a feature of a character in order to make the game easier to play.

6. Claims 61 & 62 rejected under 35 U.S.C. 103(a) as being unpatentable over Hara in view of Yamada (US Patent Number 6,398,651).

Claim 61: As discussed in detail above, Yokoyama teaches the invention substantially as claimed, but does not teach the game card being machine-readably recorded with image data for displaying the image of a character on the display screen. It is well within the capability of Hara to store such data. Yamada teaches storing such information on cards and displaying the image data read from the card on the screen. This adds to the visual interest of the card game. It would have been obvious to one of ordinary skill in the art at the time of the invention to have machine-readably stored image information on cards and displaying the image data read from the card on the screen in order to add to the visual interest of the card game.

Claim 62: Yokoyama teaches a game card that records the identification and characteristic data as an array of dots distributed within blocks. (Figs 27a-30)

Response to Arguments

7. Applicant's arguments with respect to claims 1& 7-72 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Reference Name	US Patent Number	Applicability
Murata	5,586,238	Card game with barcode
Kaneko	5,331,141	Barcode reader for game

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cbc

JESSICA HARRISON
PRIMARY EXAMINER